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PATENT

2005-0225
17

Re: Application : Shao-Hua Guo et al. Case No. : 01-2580A
Serial No : 09/934,878 Art Unit No : 1621
Filed : August 22, 2001 Examiner : Elvis O. Price
For : PREPARATION OF ACRYLIC POLYOLS
APPEAL NO. 2005-0225 - **APPELLANTS: GUO ET AL.**

Enclosed are the following documents related to the above-identified application:

- | | |
|---|--|
| (X) Return Receipt of Postcard | () Request for Reconsideration |
| (X) Certificate of Mailing Indicated Below | () Declaration Under 37 CFR 1.131 |
| () Preliminary Amendment | () Declaration Under 37 CFR 1.132 |
| () Assignment for Recordal | () Terminal Disclaimer 37 CFR 1.321(b) |
| () Information Disclosure Statement Under 37 CFR 1.97(b)(1) | () Notice of Appeal |
| () Associate Power of Attorney | () Brief |
| () Response to Restriction Requirement | () Amendment After Allowance 37 CFR 1.312 |
| () One Month Extension of Time Under 37 CFR 1.136 | () Request for Corrected Filing Receipt |
| () Reply Under 37 CFR 1.121 | () Certificate Under 37 CFR 3.73(b) |
| (X) Response to Supplemental Examiner's Answer with attachments | () Petition to Correct Inventorship Under 37 CFR 1.48 |
| | () Request for Corrected Filing Receipt |

The fee has been calculated as shown below:

CLAIMS AS AMENDED

		Highest No.			
		Previously	Present	Add'l	
		Paid for	Extra	Rate	Fee
Total Claims:	minus :	:	:	x \$ 50	: \$ 0.00
Ind. Claims:	minus :	:	:	x \$ 200	: 0.00
Fee for Notice of Appeal				\$:
TOTAL FEE DUE				\$:

- (X) No additional fee is required.
- () Charge _____ to Deposit Account No. 01-2230. A duplicate copy of this sheet is enclosed.
- (X) Please charge any additional fees or credit overpayment to Deposit Account No. 01-2230.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail, with sufficient postage, in an envelope addressed to: Mail Stop: Appeals
Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on February 15, 2006.

Linda J. Marchione
Name of Person Signing

Linda J. Marchione

Shao-Hua Guo
Shao-Hua Guo
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February 15, 2006
CUSTOMER NUMBER: 24114



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants : Shao-Hua Guo et al.
Application Number : 09/934,878
Appeal Number : 2005-0225
Filed : August 22, 2001
Title : PREPARATION OF ACRYLIC POLYOLS
Group Art Unit : 1621
Examiner : Elvis O. Price
Docket No. : 01-2580A

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

RESPONSE TO SUPPLEMENTAL EXAMINER'S ANSWER

Sir:

Please enter the following response to the Supplemental Examiner's Answer dated December 27, 2005 concerning the above-identified Appeal (No. 2005-0225). Remarks start on page 2 of this paper.

Remarks

The Board of Patent Appeals and Interferences remanded this case to the Examiner on Jan. 19, 2005. The Board asked the Examiner to make clear whether Appellants' exhibit Principles of Polymerization by George Odian was submitted before the case was appealed.

In the Supplemental Examiner's Answer filed on December 27, 2005, the Examiner told the Board that Appellants did not submit the exhibit until 3/24/04 and that he neither considered nor entered the exhibit. This is simply not true.

First, the record indicates that Appellants submitted the exhibit in an Amendment filed on 9/25/03 (attached). Please see the 9/25/03 Amendment, Part II, "Reasonable Expectation of Success," the third full paragraph on page 8.

Second, contrary to the Examiner's statement that the Examiner did not consider and did not enter the exhibit, the record indicates that the Examiner had considered and entered the Appellant's 9/25/03 Amendment on 11/18/03. See Examiner's Office Action on 11/18/03 (attached). The record nowhere indicates that the Examiner did not consider or did not enter the exhibit except that he said so in the Supplemental Examiner's Answer after the Honorable Board had challenged the Examiner on this matter.

In view of the record and the reason stated in Appellants' Appeal Brief, Appellants firmly believe that the Honorable Board should decide this case in favor of Appellants.

Respectfully submitted,
Shao-Hua Guo et al.

By: 

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02/15/2006



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,878	08/22/2001	Shao-Hua Guo	01-2580A	9259

24114 7590 11/18/2003

LYONDELL CHEMICAL COMPANY
3801 WEST CHESTER PIKE
NEWTOWN SQUARE, PA 19073



EXAMINER

PRICE, ELVIS O

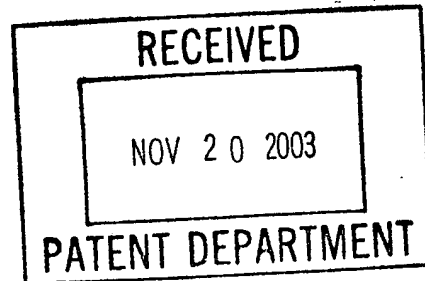
ART UNIT PAPER NUMBER

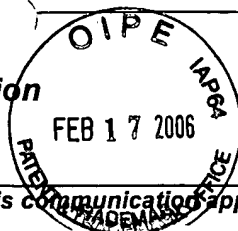
1621

DATE MAILED: 11/18/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.



Advisory Action

Application No.

09/934,878

Applicant(s)

GUO ET AL.

Examiner

Elvis O. Price

Art Unit

1621

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 29 September 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1,3-11 and 14-18.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 5. does NOT place the application in condition for allowance because: the amended claims were submitted to correct minor informalities (e.g. incorrect chemical formula) and hence the subject matter of the presently amended claims is the same subject matter that was previously rejected, for reasons of record given in the office action dated 7/11/03.


PORFIRIO NAZARIO-GONZALEZ
PRIMARY EXAMINER
GROUP 1200
A600